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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,999	11/29/1999	JOHN ROBERT PORTER	CELL-0086	8439

7590 03/21/2002

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT PAPER NUMBER

1624

DATE MAILED: 03/21/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/450,999

Applicant(s)

PORTER ET AL.

Examiner

Thomas McKenzie Ph.D.

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 14.

Claim(s) objected to: _____.

Claim(s) rejected: 2-13, 15-17 and 19-22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20.
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicants' deletion of "solvates" overcomes the indefiniteness rejection made in point #3 of the Final rejection. Applicants' amendments specifying the particular substituents claimed overcomes the indefiniteness rejection made in point #4. Applicants' amendment to claim 17, spelling out the diseases which are intended to be treated overcomes the enablement rejection made to that claim in point #6. Applicants' argument regarding the publication date of Astles (WO 99/23063 A1) as after the applications' effective filing date is correct. Thus, the anticipation rejection made in point #7 is withdrawn.

Continuation of 10. Other: This action is in response to amendments filed on 2/21/02. Applicants have amended claims 7, 9, 10, 13, 14, 16, and 17. Applicants have cancelled claim 18. There are twenty pending claims. Claims 2-14 and 16 are compound claims. Claim 15 is a composition claim. Claims 17 and 19-22 are use claims. This is the fifth action on the merits. Claims 2-22 were previously rejected. The application concerns β -amidobenzenepropanoic acid compounds.

Claims 2-13, 15-17, and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 16, Applicants repeatedly refer to "heteroaliphatic", "cycloaliphatic", and "polycycloaliphatic" and "hetero polycycloaliphatic". These are all improper. To quote from Hawley (The Condensed Chemical Dictionary) "aliphatic ... characterized by straight- or branched-chain arrangement of the constituent carbon atoms." An aliphatic group may be saturated or unsaturated. An aliphatic group may not contain rings or heteroatoms. Applicants' terms "heteroaliphatic", "cycloaliphatic", and "polycycloaliphatic" and "hetero polycycloaliphatic" are not recognized in the art of organic chemistry and are oxymorons. Thus, we do not know what Applicants intend by these unique terms since the prefixes conflict with the stem word aliphatic. The Examiner suggests "alicyclic" and "saturated heterocyclic" if that is what they intend.

Applicants argue that these are art-recognized terms and cite a number of uses of each term found on the Internet in the literature and in advertisements. Applicants correctly argue that the requirements of the second paragraph require "clarity and precision" not the most precise

language possible. Applicants point to lines 7-13, page 10 of the specification as defining what meaning they intend for "heteroaliphatic"

This is not persuasive for four reasons. Firstly, although Applicants cited no US Patents containing the disputed terms, the U.S. Court of Customs and Patent Appeals wrote *In re Giolito* 188 USPQ 645: "We reject appellants' argument that the instant claims are allowable because similar claims have been allowed in a patent. It is immaterial whether similar claims have been allowed to others. See *In re Margaroli*, 50 CCPA 1400, 318 F.2d 348, 138 USPQ 158 (1963); *In re Wright*, 45 CCPA 1005, 256 F.2d 583, 118 USPQ 287 (1958); *In re Launder*, 41 CCPA 887, 212 F.2d 603, 101 USPQ 391 (1954)". The Examiner assumes that principle applies to non-patent literature usage of the terms.

Secondly, the heart of the indefiniteness question is if the terms are precise. The Examiner has cited conflicting definitions of "aliphatic" that doom such precision. The Examiner has also asked some specific questions regarding the meaning of the compound terms "heteroaliphatic" etc. If Applicants cannot answer the questions, then how is the public to understand the metes and bounds of the claims?

Thirdly, the passage in the specification cited as defining "heteroaliphatic" uses open language "include". The passage informs us that "heteroatom-containing groups", what ever that means, are also included. It occurs to the Examiner that every known function group in organic chemistry, with the exception of carbon-to-carbon multiple bonds contains a heteroatom. Does containing mean that a nitrogen atom, say, is attached to the linked carbons of an aliphatic chain or may it be inserted between two linked carbons?

Fourthly, the case law cited by the Examiner in the Final rejection has been cited twice more with approval *Ex parte CAVALLITO AND GRAY*, 160 USPQ 509, "the presently used term "lower alkyl" is certainly a considerable improvement over the expression "lower-aliphatic" in claim 1 of the prior case." *In re Lund and Godtfredsen*, 153 USPQ 625, "[t]here is no question but that the disputed terms-though they are the same as the terms used in the specification-are so broad that they embrace subject matter not described to be appellants' actual invention by means of adequate representative examples. See also *In re Holmen*, 52 CCPA 1626, 347 F.2d 852, 146 USPQ 290; *In re Cavallito*, 49 CCPA 1335, 306 F.2d 505, 134 USPQ 370. We affirm the rejection of claims 15 and 16 under section 112." Can Applicants point to working examples of compounds containing "heteroaliphatic", "cycloaliphatic", and "polycycloaliphatic" and "hetero polycycloaliphatic" so we may better understand their intended meaning?

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